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EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
2645	

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9

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/834,089	ISAACS ET AL.
	Examiner Md S Elahee	Art Unit 2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments mailed on 02/13/04 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, the phrases 'the other users' and 'the one' on page 32, lines 3 and 7 simultaneously lack sufficient antecedent basis because it appears that the phrase 'the other users' should be 'other users' and the phrase 'the one' should be 'one'.

Regarding claim 16, the phrase 'the selecting user' on page 33, line 4 lacks sufficient antecedent basis because it appears that the phrase 'the selecting user' should be 'selecting user'.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall

have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9, 11, 13, 14 and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Heinonen et al. (U.S. Patent No. 6,671,370).

Regarding claim 9, Heinonen teaches receiving a plurality of ringing indications from a plurality of callers in the network, each user selecting a unique ringing indication to identify themselves to the other users in the network (abstract; fig.2, 3; col.3, lines 13-29; ‘ringing indications’ reads on the claim ‘audible signature’).

Heinonen further teaches distributing communications between the plurality of users in the network, wherein each communication is accompanied by the unique call ringing indication of the user which initiated the communication so as to identify that user to the one or more users who are receiving the communication (fig.2, 3; col.3, lines 13-29, col.9, line 61-col.10, line 6; ‘ringing indication’ reads on the claim ‘audible signature’).

Regarding claim 11, Heinonen teaches that the callers receiving the message is played the ringing indication of the user which initiated the communication followed by the playing of the actual communication (fig.2, 3; col.3, lines 13-29, col.9, lines 13-20; ‘ringing indication’ reads on the claim ‘audible signature’).

Regarding claim 13, Heinonen teaches providing a selection of ringing indications for selection by the plurality of users (abstract; fig.2, 3; col.3, lines 13-29).

Regarding claim 14, Heinonen teaches that two or more of the plurality of users are inherently prevented from selecting the same ringing indication (fig.2, 3; col.3, lines 13-29).

Regarding claim 16, Heinonen teaches providing a selection facility for user selections of ringing indications, the ringing indications uniquely identifying the selecting user to other users in the communications network (abstract; fig.2, 3; col.3, lines 13-29, col.6, lines 17-27, col.9, line 61-col.10, line 6; 'ringing indications' reads on the claim 'audible sound identifiers').

Heinonen further teaches identifying the users to one another in the communication network, wherein identifying the users to one another comprises providing the users' selected ringing indications to one another in the course of communications between the users such that each user is identified to the other by the sound of their respective ringing indication (fig.2, 3; col.3, lines 13-29, col.9, line 61-col.10, line 6).

Regarding claim 17, Heinonen teaches that the selection facility comprises a plurality of ringing indications organized into categories (fig.2, 3; col.3, lines 13-29, col.5, line 64-col.6, line 8, col.9, line 61-col.10, line 6).

Regarding claim 18, Heinonen teaches that users are allowed to create their own ringing indications for inclusion in the selection facility (abstract; col.6, lines 17-27).

Regarding claim 19, Heinonen teaches that the ringing indications are not replayed for user inherently during repetitive communications between the users (fig.2, 3; col.3, lines 13-29, col.9, line 61-col.10, line 6).

Regarding claim 20, Heinonen teaches distributing the selected ringing indication corresponding to one user to the other users in the communications network (col.3, lines 13-29, col.9, line 61-col.10, line 6).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. (U.S. Patent No. 6,385,303) and in view of Heinonen et al. (U.S. Patent No. 6,671,370).

Regarding claim 1, Peterson teaches receiving a message from a caller (i.e., first user), the message identifying at least one callee (i.e., message recipient) (abstract; col.17, lines 9-30). (note: message left in the answering machine is only for a particular callee)

Peterson further teaches providing the message to the at least one callee, wherein when the message is provided to the at least one callee, the caller's self-announcement (i.e., sound ID) is played for the at least one callee upon delivery of the message to the at least one callee (col.4, lines 52-62, col.8, line 50-col.9, line 21, col.10, lines 38-52, col.17, lines 9-30).

However, Peterson fails to teach "the sound ID having been previously selected by the user for identifying the user to the at least one message recipient". Heinonen teaches the ringing indication (i.e., sound ID) having been previously selected by the user for identifying the user to the at least one message recipient (abstract; col.3, lines 13-29, col.6, lines 17-27). Thus, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to modify Peterson to allow the sound ID having been previously selected by the user for identifying the user to the at least one message recipient as taught by Heinonen. The motivation for the modification is to have doing so in order to provide the identity from where the incoming call being originated.

8. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. (U.S. Patent No. 6,385,303) and in view of Heinonen et al. (U.S. Patent No. 6,671,370) and further in view of Murakami et al. (U.S. Pub. No. 2001/0011293).

Regarding claim 2, Peterson in view of Heinonen fails to teach “the message received from the first user is an instant messaging communication”. Murakami teaches that the message received from the speaker (i.e., first user) is a chat (i.e., instant messaging) communication (page 1, paragraphs 0002, 0003, 0005-0007, page 2, paragraphs 0022, 0023). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Peterson in view of Heinonen to allow the message received from the first user being an instant messaging communication as taught by Murakami. The motivation for the modification is to have doing so in order to provide the real-time meeting of IRC.

Regarding claim 8 is rejected for the same reasons as discussed above with respect to claim 2. Furthermore, Peterson teaches providing the message to the at least one callee comprises playing the first user's self-announcement followed by the message (col.4, lines 52-62, col.17, lines 9-30).

9. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. (U.S. Patent No. 6,385,303) and in view of Heinonen et al. (U.S. Patent No. 6,671,370) and further in view of Epler et al. (U.S. Patent No. 6,026,156).

Regarding claim 3 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Peterson in view of Heinonen fails to teach “activity status message”. Epler teaches Distinctive Ringing (col.5, lines 61-67, col.6, lines 1, 2; ‘Distinctive Ringing’ reads on the claim ‘activity status message’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Peterson in view of Heinonen to allow activity status message as taught by Epler. The motivation for the modification is to have doing so in order to provide the contact information from where the incoming message being originated.

Regarding claim 4, Peterson in view of Heinonen fails to teach “the message provided to the at least one message recipient is an activity alert sound”. Epler teaches that the message provided to the at least one user is a Distinctive Ringing (col.5, lines 61-67, col.6, lines 1-21; ‘user’ reads on the claim ‘message recipient’ and ‘Distinctive Ringing’ reads on the claim ‘activity alert sound’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Peterson in view of Heinonen to allow the message provided to the at least one message recipient is an activity alert sound as taught by Epler. The motivation for the modification is to have doing so in order to provide the contact information from where the incoming message being originated.

Regarding claim 5, Peterson teaches that the pre-announcement alerts the at least one callee that the first caller has become active on at least one client device (col.4, lines 52-62, col.6, lines 32-45, col.17, lines 9-30; ‘pre-announcement’ reads on the claim ‘activity alert sound’).

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10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. (U.S. Patent No. 6,385,303) and in view of Heinonen et al. (U.S. Patent No. 6,671,370) and further in view of Walker et al. (U.S. Patent No. 6,397,184).

Regarding claim 6, Peterson in view of Heinonen fails to teach “the sound ID is a snippet of notes”. Walker teaches that the identification is an audio snippet (abstract; col.3, lines 34-47; ‘identification’ reads on the claim ‘sound ID’ and ‘audio snippet’ reads on the claim ‘snippet of notes’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Peterson in view of Heinonen to allow the sound ID as a snippet of notes as taught by Walker. The motivation for the modification is to have doing so in order to provide the identification display.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. (U.S. Patent No. 6,385,303) and in view of Heinonen et al. (U.S. Patent No. 6,671,370) and further in view of Meffert et al. (U.S. Pub. No. 2002/0059144).

Regarding claim 7, Peterson in view of Heinonen fails to teach “the sound ID is at least a portion of a popular song”. Meffert teaches that the sound ID is at least a portion of a popular song (page 11, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Peterson in view of Heinonen to allow the sound ID being at least a portion of a popular song as taught by Meffert. The motivation for the modification is to have doing so in order to provide the attractive sound.

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12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen et al. (U.S. Patent No. 6,671,370) and in view of Meffert et al. (U.S. Pub. No. 2002/0059144).

Regarding claim 10, Heinonen teaches that the unique ringing indication is a portion of a song recognized by the subscribers as identifying the caller (page 2, paragraph 0025, page 12, paragraph 0148; ‘ringing indication’ reads on the claim ‘audible signature’, ‘subscribers’ reads on the claim ‘receiving users’ and ‘caller’ reads on the claim ‘initiating user’).

However, Heinonen fails to teach “the unique audible signature is a portion of a song”. Meffert teaches that the unique audible signature is at least a portion of a popular song (page 11, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heinonen to allow the unique audible signature being at least a portion of a popular song as taught by Meffert. The motivation for the modification is to have doing so in order to provide the attractive sound.

13. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen et al. (U.S. Patent No. 6,671,370) and in view of Reformato et al. (U.S. Patent No. 6,229,880).

Regarding claim 12, Heinonen fails to teach “activity status update”. Reformato teaches status information update (col.14, lines 17-29; ‘status information update’ reads on the claim ‘activity status update’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heinonen to allow

activity status update as taught by Reformato. The motivation for the modification is to have doing so in order to provide the change in the status information.

Regarding claim 15, Heinonen fails to teach “the audible signature is preceded by an activity signal, the activity signal based upon the activity level of the initiating user”. Reformato teaches that the identification is preceded by a status information, the status information based upon the activity level of the subscriber (col.14, lines 17-29; ‘identification’ reads on the claim ‘audible signature’, ‘status information’ reads on the claim ‘activity signal’ and ‘subscriber’ reads on the claim ‘initiating user’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Heinonen to allow the audible signature being preceded by an activity signal, the activity signal based upon the activity level of the initiating user as taught by Reformato. The motivation for the modification is to have doing so in order to provide the status information of the message.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Slotnick (U.S. Pub. No 2001/0033298) teach Adjunct use of instant messenger software to enable communications to or between chatterbots or other software agents. Harada et al. (U.S. Patent No. 6,434,604) teach Chat system allows user to select balloon form and background color for displaying chat statement data.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (703)305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

M.E.

MD SHAFIUL ALAM ELAHEE

May 13, 2004

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